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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215770
Party	Defendant SCLC, Inc.
Correspondence Address	KEITH E ROUNDER TERRELL BAUGH SALMON & BORN LLP 700 S GREEN RIVER RD , STE 2000 EVANSVILLE, IN 47715-7907 UNITED STATES krounder@tbsblaw.com, lvancleve@tbsblaw.com
Submission	Answer
Filer's Name	Keith E. Rounder
Filer's e-mail	krounder@tbsblaw.com
Signature	/Keith E. Rounder/
Date	05/07/2014
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

UNIVERSITY OF SOUTHERN
CALIFORNIA,

Opposer,

v.

SCLC, Inc.,

Applicant.

Opposition No.: 91215770

Serial No.: 86/060018

Mark: **SC ATHLETICS**

Filed: September 10, 2013

Published: March 4, 2014

RESPONSE TO OPPOSITION

Comes now the Applicant, SCLC, Inc., by counsel, and for its Response to Notice of Opposition ("Opposition") filed by the Opposer, the University of Southern California, states as follows:

1. Based on Opposer's previous request to extend the time in which to oppose the SC ATHLETICS Application, the deadline to file a Notice of Opposition is May 3, 2014.

ANSWER: The Applicant is without sufficient knowledge or information from which to form a good faith belief as to the truth or falsity of the allegations contained in paragraph 1 of the Opposition.

2. On knowledge and belief, the SC ATHLETICS Application is owned by SCLC, Inc., a corporation organized under the laws of the State of Delaware having a principle address of 7500 E. Columbia Street, Evansville, IN 47715-9127.

ANSWER: The Applicant admits the allegations contained in paragraph 2 of the Opposition.

3. According to the current records of the United States Patent and Trademark Office, the SC ATHLETICS Application is an application for registering a mark in typed form with the working of "SC ATHLETICS" in International Class 35 for retail store services in the field of footwear.

ANSWER: The Applicant admits the allegations contained in paragraph 3 of the Opposition.

4. Opposer is the oldest private research university in the Western United States, with a national and international reputation for both academic and athletic excellence. Opposer has not only provided a wide variety of collegiate goods and services on its own account, but Opposer has licensed various goods and services under the name SC and various related marks for decades. Opposer and its authorized licensees have used the SC mark and various related marks including SC in commerce continuously since at least 1926. Opposer's SC mark is a highly distinctive collegiate mark and through extensive advertising and use, the SC mark has become strongly associated with Opposer's goods and services. In particular, without limitation:

ANSWER: The Applicant is without sufficient knowledge or information from which to form a good faith belief as to the truth or falsity of the allegations contained in paragraph 4 of the Opposition.

5. Opposer is the owner of Federal Registration 2,683,137 for the mark "S C" for a number of goods and services including International Class 35 for "On-line retail store services featuring men's, women's and children's clothing, **footwear**, hats, accessories, sporting goods, gifts and novelty items." This registration also includes International Class 41 for "Entertainment Services, namely conducting **athletic**

competitions, organizing intercollegiate community and national sporting and cultural events; **sports instruction**, and providing musical, band, dance, theatrical and dramatic performances.” This registration also includes goods in International Class 28 for “**Sporting goods**, namely, baseballs, footballs, golf balls, golf tees, golf bags, golf club covers, and foam fingers; arcade-type electronic video games; playthings, namely plush toys.” This registration also includes goods in International Class 25 for “clothing, namely, t-shirts, sweatshirts, polo shirts, warm-up suits, jackets, rain ponchos, sweaters, jerseys, tank tops, shorts, sport shirts, baseball shirts, basketball jerseys, golf sweaters, night shirts, boxer shorts, socks, hats, caps, sport caps, visor caps, beanies and ties.” This registration further includes goods in International Class 24 for “Towels, stadium blankets, cloth pennants, and cloth flags.” This registration further includes goods in International Class 21, 18, 16 and 12. Registration No. 2,683,137 is valid, subsisting and incontestable. Opposer has used the SC mark and various related marks in connection with clothing continuously since at least 1994.

ANSWER: With respect to the allegations contained in paragraph 5 of the Opposition, Applicant admits that Opposer is the owner of Federal Registration 2,683,137 for the mark “S C” but denies the remaining allegations contained in paragraph 5.

6. Opposer is also the owner of Federal Registration 1,844,953 for the mark “SC” for goods in International Classes 6, 8, 24 and 25. Registration No. 1,844,953 is valid, subsisting and incontestable. Opposer has used the SC mark and various related marks in connection the with sales of such goods since at least 1987.

ANSWER: With respect to the allegations contained in paragraph 6 of the Opposition, Applicant admits that Opposer is the owner of Federal Registration 1,844,953 for the mark “SC” but denies the remaining allegations contained in paragraph 6.

7. Opposer is also the owner of common law rights in the mark SC and various related marks arising from Opposer’s educational and athletic programs beginning at least as early as 1926. Opposer’s common law rights include the use of various forms of the SC mark in both goods and services connected with the Opposer’s athletics program. Opposer operates its own retail stores and has further manufactured and/or licensed a wide variety of athletic-related goods to others to be sold through a wide variety of retail channels. The use of the SC mark and related marks (whether by Opposer or by its licenses) inures to the benefit of Opposer and provides Opposer with additional common law rights upon which Opposer relies in this Opposition.

ANSWER: The Applicant is without sufficient knowledge or information from which to form a good faith belief as to the truth or falsity of the allegation contained in paragraph 7 of the Opposition.

8. As a result of extensive advertisement, promotion and sale of goods and services using the SC mark, the mark has gained widespread and favorable public acceptance and recognition. The University of Southern California’s SC mark (and related marks) are associated with and identify the Opposer.

ANSWER: The Applicant is without sufficient knowledge or information from which to form a good faith belief as to the truth or falsity of the allegation contained in paragraph 8 of the Opposition.

9. Opposer has developed valuable good will with respect to the SC mark.

ANSWER: The Applicant is without sufficient knowledge or information from which to form a good faith belief as to the truth or falsity of the allegation contained in paragraph 9 of the Opposition.

10. The SC mark is a famous and distinctive mark, and represents an asset of incalculable value as a symbol of Opposer, the University of Southern California, its quality goods and services, and its goodwill.

ANSWER: The Applicant is without sufficient knowledge or information from which to form a good faith belief as to the truth or falsity of the allegation contained in paragraph 10 of the Opposition.

11. Opposer believes that it will be damaged by the registration of the Applicant's proposed mark both because an appreciable number of members of the consuming public may improperly assume that Applicant's services are associated with, endorsed by, or affiliated with Opposer and further because registration of the Applicant's proposed mark would lead to tarnishment and/or dilution of Opposer's established registration and common law rights in SC and various related marks. Opposer therefore has a real interest and a direct stake in the outcome of the proceeding and oppose opposes the registration in whole.

ANSWER: With respect to the allegations contained in paragraph 11 of the Opposition, Applicant denies that Opposer will be damaged by the registration of Applicant's proposed mark and denies that the use by Applicant of its proposed mark would create confusion among the consuming public or

otherwise damage the interests of the Opposer. Consequently, Applicant also denies the allegations made in the second sentence of paragraph 11.

12. Opposer's trademark rights in the SC mark are valid, subsisting and have not been abandoned. Applicant's application was filed claiming a first use date of May 2013, and as such, Opposer's rights have priority.

ANSWER: With respect to the allegations contained in paragraph 12 of the Opposition, Applicant states that it is without sufficient knowledge or information from which to form a good faith belief as to the truth or falsity of the allegations contained in the first paragraph thereof and denies the allegations contained in the second paragraph thereof.

13. Opposer's SC mark and its related marks are similar to the dominant part of Applicant's mark in sight and sound. Moreover, Opposer offers a nationally and internationally famous athletics program which Opposer actively promotes using its SC and related marks. Although Applicant's mark may not create confusion when used locally within Applicant's own "Shoe Carnival" stores in the mid-west, Applicant's proposed national application without any restrictions as to use would create a confusingly similar mark.

ANSWER: With respect to the allegations contained in paragraph 13 of the Opposition, Applicant denies that Opposer's SC mark and its related marks are similar to the dominant part of Applicant's mark in sight and sound. With respect to the allegation that Opposer offers a nationally and internationally famous athletic program which Opposer actively promotes using its SC and related marks, Applicant states that it is without sufficient knowledge or

information from which to form a good faith belief as to the truth or falsity of that allegation. Applicant denies that its proposed international application without any restrictions as to use would create a confusingly similar mark.

14. If Applicant were granted the registration herein opposed, a registration for the SC ATHLETICS mark in typed form would provide Applicant at least a *prima facie* exclusive right to use the term in any reasonable stylization including the various stylizations used by and associated with Opposer. Moreover, if Applicant were granted the registration herein opposed, Applicant would thereby obtain at least *prima facie* exclusive right to use the mark across the nation in any retail context for the sale of footwear. Such registration would cause damage and injury to Opposer.

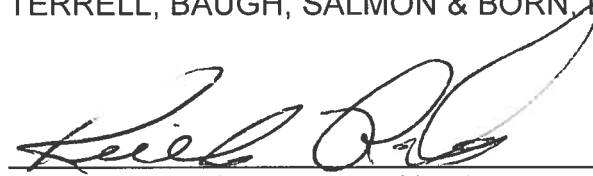
ANSWER: With respect to the allegations contained in paragraph 14 of the Opposition, Applicant admits that if it were granted the proposed registration, a registration for the SC ATHLETICS mark in type form would provide Applicant with at least *prima facie* exclusive rights to use the term in any reasonable stylization including various stylization used by and with Opposer. Applicant also admits that if it were granted the proposed registration, it would obtain at least a *prima facie* exclusive rights to use the mark across the United States of America in any retail context for the sale of footwear. Applicant denies that the proposed registration, if granted, would cause any damage or injury to Opposer.

WHEREFORE, Applicant prays that Opposer be denied the relief it seeks in its Opposition, that Applicant's application Serial No. 86/060018 be approved and for all other relief as is just and proper in the premises.

Respectfully submitted,

TERRELL, BAUGH, SALMON & BORN, LLP

By:



Keith E. Rounder, Attorney No. 13758-53
Gary K. Price, Attorney No. 15051-82
700 South Green River Road, Suite 2000
Evansville, IN 47715
Phone: (812) 479-8721
Fax: (812) 474-6059
ATTORNEYS FOR APPLICANT, SCLC, INC.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document or pleading was placed in the United States mail, first class, postage pre-paid, addressed to the following on May 7, 2014.

Michael S. Adler
TANTALO & ADLER, LLP
1901 Avenue of the Stars, Suite 1000
Los Angeles, CA 90067



Keith E. Rounder